

### **REMARKS**

Claim 1 is amended. Claims 2 to 13 are cancelled without prejudice or disclaimer. Claim 14 is added. Claims 1 and 14 are currently pending.

Support for the amendment to claim 1 is found in the specification, e.g., at page 19, lines 11 to 15, and at page 7, lines 21 to 36. Support for new claim 14 is found in the specification, e.g., at page 19, lines 11 to 15. Thus, the amendments are fully supported by the specification.

Applicants have also amended the specification to include the current address of the American Type Culture Collection.

### **Claim Objections**

The Examiner objects to claims 5 and 9 as allegedly containing improper Markush-type language. See Action at page 2. Applicants have cancelled claims 5 and 9 without prejudice or disclaimer. Thus, the Examiner's objection is moot.

The Examiner objects to claim 6 as allegedly containing terminology not recognized by the Examiner. See *id.* Applicants have cancelled claim 6 without prejudice or disclaimer. Thus, the Examiner's objection is moot.

The Examiner objects to claim 4, as allegedly containing informalities, but does not specify those informalities. See *id.* In any event, applicants have cancelled claim 4 without prejudice or disclaimer. Thus, the Examiner's objection is moot.

#### Rejection of Claims 1 and 2 Under 35 U.S.C. § 101

The Examiner rejects claims 1 and 2 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. See Action at page 2. Specifically, the Examiner alleges that “the claims read on naturally occurring *E. coli*.” See *id.*

First, applicants have cancelled claim 2 without prejudice or disclaimer. Thus, the Examiner’s rejection of that claim is moot.

Second, solely to expedite prosecution, and without acquiescing to the Examiner’s rejections, applicants have amended claim 1 to recite “an isolated strain” as suggested by the Examiner. That amendment should obviate the Examiner’s § 101 rejection.

Applicants request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 101.

#### Rejection of Certain Claims Under 35 U.S.C. § 112, first paragraph

The Examiner rejects claims 1 and 3 to 10 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. See Action at page 3. The Examiner alleges that “[t]he claims read on a broad genus of *E. coli* cells having any *Hte* mutation and more efficient transformation with foreign plasmids, and methods of preparing gram negative bacteria of improved competence comprising transferring a polynucleotide encoding any *Hte* mutation into said cells.” See *id.* Specifically, the Examiner alleges that “...the specification does not sufficiently

describe a representative number of species by actual reduction to practice or by disclosure of relevant identifying characteristics.” See Action at page 4.

First, applicants have cancelled claims 3 to 10 without prejudice or disclaimer. Thus, the Examiner’s rejection of those claims is moot.

Second, solely to expedite prosecution, and without acquiescing to the Examiner’s rejection, applicants have amended claim 1 to recite “an *Hte* mutation included in the strain deposited as ATCC No. 55962.” That amendment should obviate the Examiner’s rejection.

Applicants request reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 112, first paragraph.

The Examiner also rejects claim 2 under 35 U.S.C. § 112, first paragraph, for allegedly failing to comply with the enablement requirement. See Action at page 5. The Examiner states that the applicants must provide a statement concerning the availability of the strain deposited as ATCC 55962. See *id.* Applicants have cancelled claim 2 without prejudice or disclaimer. Thus, the Examiner’s rejection of that claim is moot.

However, applicants note that amended claim 1 now refers to “the strain deposited as ATCC No. 55962.” Consequently, solely to expedite prosecution, applicants provide a copy of a statement concerning the availability of that strain,

which was submitted in U.S. Patent Application No. 08/846,996, now U.S. Patent No. 6,706,525 B1.

Rejection of Claims 2, 12, and 13 Under 35 U.S.C. § 112, first paragraph

The Examiner rejects claims 2, 12, and 13, under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. See Action at page 6. Applicants have cancelled claims 2, 12, and 13, without prejudice or disclaimer. Thus, the Examiner's rejection of those claims is moot.

Rejection of Claims 12 and 13 Under 35 U.S.C. § 101

The Examiner rejects claims 12 and 13 under 35 U.S.C. § 101, as allegedly being in an improper "use" format. See Action at page 7. Applicants have cancelled claims 12 and 13 without prejudice or disclaimer. Thus, the Examiner's rejection of those claims is moot.

Double Patenting

The Examiner rejects claims 1 to 10 under the judicially created doctrine of obviousness-type double patenting over certain claims of U.S. Patent No. 6, 705,525. See Action at page 8. Without acquiescing to the rejection, if the claims are otherwise found in condition for allowance, applicants will file a terminal disclaimer.

Please grant any extensions of time required to enter this paper and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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